

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Date: January 18, 2006

STEPHEN F. GASS

Serial No.: 09/676,190

Examiner Boyer D. Ashley

Filed: September 29, 2000

Group Art Unit 3724

For: SAFETY SYSTEMS FOR POWER EQUIPMENT

To: Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.704(B)

Applicant requests reconsideration of the patent term adjustment indicated in the notice of allowance pursuant to 37 CFR 1.705(b).

1. Fee Set Forth in 1.18(e).

An authorization to charge a credit card for the \$200 fee set forth in 37 CFR 1.18(e) is attached.

2. Statement of Facts Involved.**(i) The Correct Patent Term Adjustment and Bases for the Adjustment.**

The patent term adjustment indicated in the notice of allowance included a USPTO Delay of 270 days and an Applicant Delay of 295 days, for a patent term adjustment of 0 days, as shown on the Patent Application Information Retrieval (PAIR) web site (<http://pair.uspto.gov>). The correct patent term adjustment should include a USPTO Delay of 372 days and an Applicant Delay of 293 days, which results in a patent term adjustment of 79 days. This is explained below.

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Applicant filed this application on September 29, 2000 with 20 claims. A few months later, applicant filed a Preliminary Amendment cancelling claims 1-20 and replacing them with new claims 21-34. The Preliminary Amendment was received by the USPTO on March 2, 2001, as shown by a return-receipt postcard. Unfortunately, however, the Preliminary Amendment must have been lost by the USPTO because on August 23, 2002 the Examiner mailed a restriction requirement concerning the original 20 claims. Applicant responded by pointing out that the restriction requirement addressed the wrong claims and was therefore incorrect. Applicant also resubmitted the Preliminary Amendment with the return-receipt postcard. The Examiner accepted applicant's response and mailed a new restriction requirement on December 3, 2002 concerning claims 21-34.

The first restriction requirement mailed August 23, 2002 was not an action under 35 USC 132 because it did not reject claims or make any legitimate objection or requirement, as required by the statute. The Examiner's restriction requirement concerning claims 1-20 was not a legitimate or bona fide objection or requirement because those claims had been cancelled almost 1½ years earlier. Thus, the first action from the Examiner that met the requirements of 35 USC 132 was the restriction requirement mailed December 3, 2002. This conclusion is consistent with other cases discussing the policy behind 35 USC 132, such as Application of Hayashibara, 525 F.2d 1062, 1065 n.3, 188 USPQ 4 (CCPA 1975) ("35 U.S.C. §132 requires that the Commissioner state grounds of rejection with sufficient clarity that applicants will be able to decide what to do next") and Application of Ludtke, 441 F.2d 660, 662 (CCPA

1971) (procedural due process and 35 U.S.C. 132 require adequate notice to applicants of reasons for rejections).

The patent term adjustment, however, was calculated as if the restriction requirement mailed August 23, 2002 was a proper action under 35 USC 132. That was error because, as explained, the USPTO lost applicant's Preliminary Amendment and that mistake delayed the prosecution of the application. The patent term should now be adjusted to correct the delay resulting from that mistake. Any other conclusion would unjustly deprive applicant of patent term and unfairly assign the consequences of the mistake to applicant. See Application of Ornitz, 376 F.2d 330, 332 (CCPA 1967) (ambiguity in an opinion from the Board of Appeals should not be held against applicant in light of 35 USC 132). The correct calculation of the USPTO Delay under 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1) should consider December 3, 2002 as the date a first action under 35 USC 132 was mailed. That would result in an increase in the USPTO Delay by an additional 102 days for a total USPTO Delay of 372 days.

Additionally, 2 days were incorrectly counted as Applicant Delay because applicant submitted an Information Disclosure Statement that was received by the USPTO on September 18, 2002, two days after applicant responded to the August 23, 2002 restriction requirement. Those 2 days do not constitute delay under 37 CFR 1.704(c)(8) because the August 23, 2002 restriction requirement was not an action under 35 USC 132. In other words, the Information Disclosure Statement was filed prior to the first action under 35 USC 132, and therefore, it was not a "supplemental reply or other paper," as those terms are used in 37 CFR 1.704(c)(8). Accordingly, the total

Applicant Delay used to calculate the Patent Term Adjustment should be reduced by 2 days, resulting in a total of 293 days.

(ii) The Relevant Dates and Adjustment Specified in §1.703(f).

As explained above, the relevant date for a first action under 35 USC 132 is December 3, 2002. That date is 14 months and 369 days from the filing date of September 29, 2000. The USPTO subsequently delayed an extra 3 days in mailing the Notice of Allowance, which results in a total USPTO Delay of 372 days. Two days should be subtracted from the Applicant Delay because the Information Disclosure Statement received on September 18, 2002 was prior to the first action under 35 USC 132, as explained. With these corrections, the adjustment as specified in 37 CFR 1.703(f) to which the patent is entitled is:

	<u>Days</u>
USPTO Delay	372
Applicant Delay	293
Total PTA	79

(iii) Terminal Disclaimer.

This application at hand is not subject to a terminal disclaimer.

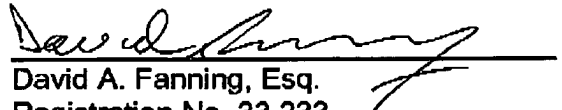
(iv) Circumstances that Constitute a Failure to Engage in Reasonable Efforts to Conclude Examination.

The current PAIR calculation of patent term adjustment includes a failure to engage in reasonable efforts to conclude examination under 37 CFR 1.704(c)(8) for

submission of an Information Disclosure Statement, as explained. Applicant disputes that calculation and asserts that there was no such delay.

Respectfully submitted,

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Renee Knight